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09/586,410	06/01/2000	Mark Clark	00 P 7661 US	6338

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Siemens Corporation  
Intellectual Property Department  
186 Wood Avenue South  
Iselin, NJ 08830

EXAMINER

NAHAR, QAMRUN

ART UNIT	PAPER NUMBER
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2124

DATE MAILED: 03/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/586,410

Applicant(s)

CLARK ET AL.

Examiner

Qamrun Nahar

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This action is in response to the RCE filed on 12/15/03.
2. Claims 1, 6, 11 and 16 have been amended.
3. Claims 1-18 are pending.
4. The objection to claim 2 is pending.
5. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claims 1, 6, 11, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Chang (U.S. 5,230,049).
7. Claims 2, 7, 12, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (U.S. 5,230,049) in view of Bapat (U.S. 5,291,583).
8. Claims 3-5, 8-10, 13-15, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (U.S. 5,230,049) in view of Bapat (U.S. 5,291,583), and further in view of Applicant Admitted Prior Art (hereinafter AAPA).

### *Response to Amendment*

#### *Claim Objections*

9. Claim 2 is objected to because of the following informalities: Even though, claim 2 has been indicated to be "Currently Amended", however, no amendment has been made. Particularly, the applicant has inadvertently failed to underline the missing period. Therefore, claim 2 has been treated as the original claim. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 1 and 11, these claims have been amended to recite “translate directly”; as per claim 6, this claim has been amended to recite “translating ... directly”; and as per claim 16, this claim has been amended to recite “directly translating”. The term *directly* renders these claims indefinite because this term is not defined in the specification and the scope of that limitation cannot be grasped. Therefore, this limitation is interpreted as translate/translating.

As per claims 2-5, 7-10, 12-15 and 17-18, these claims are rejected for dependency upon rejected parent claims above.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1, 6, 11, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Chang (U.S. 5,230,049).

**Per Claim 1 (Amended, as best understood):**

The Chang patent discloses:

- **a system** (“system” in column 2, lines 46-47 and Fig. 1)
- **a translator adapted to translate directly between extended grammar constructs of a machine readable language and basic grammar constructs of said machine readable language** (“pre-compiler” in column 2, lines 53-68 to column 3, lines 1-6, pre-compiler is interpreted as a translator; supplemental language is interpreted as extended grammar constructs; and host language is interpreted as basic grammar constructs)
- **a compiler coupled to receive an output of said translator for compiling code written in said basic grammar constructs** (“The modified source file 22 can then be compiled by a host language compiler 24” in column 3, lines 13-16).

**Per Claim 6 (Amended, as best understood):**

This is a method version of the claimed system discussed above, claim 1, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above, including “a first source file” (column 2, lines 59-60), and “a second source file” (column 3, lines 3-6). Thus, accordingly, this claim is also anticipated by Chang.

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**Per Claim 11 (Amended, as best understood):**

This is a method version of the claimed system discussed above, claim 1, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above.

Thus, accordingly, this claim is also anticipated by Chang.

**Per Claim 16 (Amended, as best understood):**

This is a computer-readable computer program product version of the claimed system discussed above, claim 1, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above, including “wherein said computer-readable program code is adapted to directly translate said extended grammar constructs into said basic grammar constructs by using one or more lookup tables” (column 3, lines 1-6 and Fig. 1, item 36). Thus, accordingly, this claim is also anticipated by Chang.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 2, 7, 12, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (U.S. 5,230,049) in view of Bapat (U.S. 5,291,583).

**Per Claim 2 (as best understood):**

The rejection of claim 1 is incorporated, and further, Chang does not explicitly teach that the machine readable language comprises an Abstract Syntax Notation One (ASN.1) standard. Bapat teaches that the machine readable language comprises the Abstract Syntax Notation One (ASN.1) standard (column 3, lines 10-16 and see Fig. 20, item 14 "ASN.1 SOURCE FILES WITH OBJECT CLASS DEFINITIONS"; ASN.1 source files contain ASN.1 grammar constructs, which is compiled into machine readable language).

It would have been obvious to one having ordinary skill in the computer art at the time of the invention was made to modify the system disclosed by Chang to include the machine readable language comprising the Abstract Syntax Notation One (ASN.1) standard using the teaching of Bapat. The modification would be obvious because one of ordinary skill in the art would be motivated to use standardized data structure protocol.

**Per Claim 7 (as best understood):**

This is a method version of the claimed system discussed above, claim 2, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim also would have been obvious.

**Per Claim 12 (as best understood):**

This is a method version of the claimed system discussed above, claim 2, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim also would have been obvious.

**Per Claim 17 (as best understood):**

This is a computer-readable computer program product version of the claimed system discussed above, claim 2, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim also would have been obvious.

16. Claims 3-5, 8-10, 13-15, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (U.S. 5,230,049) in view of Bapat (U.S. 5,291,583), and further in view of Applicant Admitted Prior Art (hereinafter AAPA).

**Per Claim 3 (as best understood):**

The rejection of claim 2 is incorporated, and further, neither Chang nor Bapat explicitly teaches that the basic grammar constructs comprises X.680 grammar constructs. AAPA teaches that the basic grammar constructs comprises X.680 grammar constructs (pg. 1, line 32).

It would have been obvious to one having ordinary skill in the computer art at the time of the invention was made to modify the system disclosed by the combination of Chang and Bapat to include the basic grammar constructs comprising X.680 grammar constructs using the teaching of AAPA. The modification would be obvious because one of ordinary skill in the art would be motivated to use a common basic compiler.

**Per Claim 4 (as best understood):**

The rejection of claim 3 is incorporated, and further, neither Chang nor Bapat explicitly teaches that the extended grammar constructs comprises at least one of X.681, X.682, or X.683



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grammar constructs. AAPA teaches that the extended grammar constructs comprises at least one of X.681, X.682, or X.683 grammar constructs (pg. 1, lines 27-31).

It would have been obvious to one having ordinary skill in the computer art at the time of the invention was made to modify the system disclosed by the combination of Chang and Bapat to include the extended grammar constructs comprising at least one of X.681, X.682, or X.683 grammar constructs using the teaching of AAPA. The modification would be obvious because one of ordinary skill in the art would be motivated to develop applications using other grammar constructs.

**Per Claim 5 (as best understood):**

The rejection of claim 4 is incorporated, and Chang further teaches that the translator comprising one or more lookup tables (column 3, lines 1-6 and Fig. 1, item 36).

**Per Claim 8 (as best understood):**

This is a method version of the claimed system discussed above, claim 4, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above.

Thus, accordingly, this claim also would have been obvious.

**Per Claim 9 (as best understood):**

This is a method version of the claimed system discussed above, claim 3, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above.

Thus, accordingly, this claim also would have been obvious.

**Per Claim 10 (as best understood):**

This is a method version of the claimed system discussed above, claim 5, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above, including “equivalent constructs” (Chang, column 3, lines 1-6). Thus, accordingly, this claim also would have been obvious.

**Per Claims 13-15 (as best understood):**

These are method versions of the claimed system discussed above (claims 3, 4, and 5, respectively), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims also would have been obvious.

**Per Claim 18 (as best understood):**

This is a computer-readable computer program product version of the claimed system discussed above (claims 3 and 4), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim also would have been obvious.

***Response to Arguments***

17. Applicant's arguments with respect to claims 1-18 have been fully considered but they are not persuasive.

*In the remarks, the applicant argues that:*

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a) Claims 1, 6, 11, and 16 have been rejected under 35 U.S.C. §102(b) as being unpatentable over Chang, U.S. Patent No. 5,230,049 ("Chang"). In order for there to be anticipation, each and every element of the claimed invention must be present in a single prior reference. Applicants respectfully submit that the claimed invention is not taught, suggested, or implied by Chang.

As discussed in the Specification, a computer system according to an implementation of the invention implements a translator and a compiler for compiling a machine readable language, such as ASN.1. When a source file is provided, the system performs a line-by-line compare to determine if the file contains extended grammar constructs of the language. If not, then the source file is compiled. If so, however, then the source file is input to the translator to directly translate the source file into basic grammar constructs.

Thus, claim 1 has been amended to recite "a translator adapted to translate directly between extended grammar constructs of a machine readable language and basic grammar constructs of said machine readable language;" claim 6 has been amended to recite "translating said first source file directly into a second source file, said second source file containing only basic grammar constructs of said machine readable language;" claim 11 has been amended to recite "providing a translator adapted to translate directly between extended grammar constructs of a machine readable language and basic grammar constructs of said machine readable language;" and claim 16 has been amended to recite "wherein said computer-readable program code is adapted to directly translate said extended grammar constructs into said basic grammar constructs by using one or more lookup tables."

In contrast, as acknowledged in the Official Action, Chang does not relate to extended and basic ASN.1 grammar constructs. Instead, Chang relates to providing source code statements in a host language (e.g., C or Cobol) and including statements in a supplemental language (e.g., SOL). The SOL statements are extracted, converted into a "language independent format" and then into the host language. Not only are these not basic and extended ASN.1 grammar constructs, but there is no direct translation. Instead, a "language independent format" is required. As such, the Examiner is respectfully requested to reconsider and withdraw the rejections.

*Examiner's response:*

a) Examiner strongly disagrees with applicant's assertion that Chang fails to disclose the claimed limitations recited in claims 1, 6, 11 and 16. Chang clearly shows each and every limitation in claims 1, 6, 11 and 16.

Chang is not relied upon for the limitation extended or basic ASN.1 grammar constructs. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., extended and basic ASN.1 grammar constructs) are not recited in the rejected claims 1, 6, 11 and 16. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, the term "directly" in claims 1, 6, 11 and 16 renders these claims indefinite. This limitation is interpreted as translate/translating, see paragraph 11 for the rejection under 35 U.S.C. 112, second paragraph, as being indefinite. As previously pointed out in the last Office

Action, Paper No. 5, Chang teaches a translator ("pre-compiler" in column 2, lines 53-68 to column 3, lines 1-6, pre-compiler is interpreted as a translator; supplemental language is interpreted as extended grammar constructs; and host language is interpreted as basic grammar constructs).

In addition, see the rejection above in paragraph 13 for rejection to claims 1, 6, 11 and 16.

*In the remarks, the applicant argues that:*

b) Claims 2, 7, 12, and 17 were rejected under 35 U.S.C. §103 as being unpatentable over Chang in view of Bapat, U.S. Patent No. 5,291,583 ("Bapat"). Applicants respectfully submit that the present invention is not taught, suggested, or implied by Chang or Bapat, either singly or in combination. Bapat is relied on for allegedly teaching ASN.1 as "a machine readable language." Bapat, however, relates merely to "storing ASN.1 object instances in a relational database language such as SOL." Col. 1, lines 21-22. Like Chang, Bapat appears to have nothing to do with translating extended grammar constructs directly into basic grammar constructs, as generally recited in the claims at issue. As such, the Examiner is respectfully requested to reconsider and withdraw the rejections.

*Examiner's response:*

b) Examiner strongly disagrees with applicant's assertion that the combination of Chang and Bapat fails to disclose the claimed limitations recited in claims 2, 7, 12 and 17. Bapat clearly shows each and every limitation in claims 2, 7, 12 and 17. As previously pointed out in the last

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Office Action, Paper No. 5, Bapat is relied upon for the limitation "the machine readable language comprises the Abstract Syntax Notation One (ASN.1) standard" (column 3, lines 10-16 and see Fig. 20, item 14 "ASN.1 SOURCE FILES WITH OBJECT CLASS DEFINITIONS"; ASN.1 source files contain ASN.1 grammar constructs, which is compiled into machine readable language).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). That is, Chang is relied upon for the limitation translating extended grammar constructs into basic grammar constructs, not Bapat.

In addition, see the rejection above in paragraph 15 for rejection to claims 2, 7, 12 and 17.

*In the remarks, the applicant argues that:*

c) Claims 3-5, 8-10, 13-15, and 18 were rejected under 35 U.S.C. §103 as being unpatentable over Chang in view of Bapat and further in view of "Applicant Admitted Prior Art (APAA)," Chang and Bapat have been discussed above. Applicant Admitted Prior Art is indicated to merely specify particular ASN.1 grammar extensions. Because, however, APAA fails to relate in any way to a translator as recited in the claims at issue (indeed, that is a very object of the present invention), its combination with Chang and Bapat likewise falls to teach, suggest or imply the present invention. As such, the Examiner is respectfully requested to reconsider and withdraw the rejections.

*Examiner's response:*

c) Examiner strongly disagrees with applicant's assertion that the combination of Chang, Bapat, and AAPA fails to disclose the claimed limitations recited in claims 3-5, 8-10, 13-15 and 18. The combination of Chang, Bapat, and AAPA clearly shows each and every limitation in claims 3-5, 8-10, 13-15 and 18.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). That is, Chang is relied upon for the limitation translator, not Bapat or AAPA.

In addition, see the rejection above in paragraph 16 for rejection to claims 3-5, 8-10, 13-15 and 18.

***Conclusion***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

19. Any inquiry concerning this communication from the examiner should be directed to Qamrun Nahar whose telephone number is (703) 305-7699. The examiner can normally be reached on Mondays through Thursdays from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki, can be reached on (703) 305-9662. The fax phone number for the organization where this application or processing is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

QN  
February 26, 2004

*Kakali Chaki*  
**KAKALI CHAKI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100**